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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/629,063

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EXAMINER

HUFFMAN, JULIAN D

ART UNIT

PAPER NUMBER

2853

MAIL DATE

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/629,063

Applicant(s)

KABALNOV ET AL.

Examiner

Julian D. Huffman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 26 April 2007.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-5, 7, 8, 10-24 and 26-32 is/are pending in the application.
- 4a) Of the above claim(s) 2, 3, 5, 10, 11, 13, 17, 19, 21, 22 and 24 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 4, 7, 8, 12, 14-16, 18, 20, 23 and 26-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 26 April 2007 has been entered.

### ***Election/Restrictions***

2. Claims 2, 3, 5, 10, 11, 13, 17, 19, 21, 22 and 24 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 2 May 2005.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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4. Claims 1, 4, 7, 8, 12, 14-16, 18, 20, 23 and 26-32 are rejected under 35 U.S.C. 102(e) as being anticipated by Lee (U.S. 20030025321 A1).

Lee discloses:

With regards to claims 1, 4 and 7, a print medium (fig. 2) having a rewritable data storage device (fig. 2, element 8) attached thereto (section 0019), said print medium being configured to receive a printed image (layer 10 receives a printed image 14), and said data storage device being in or on only a portion of the print medium (central portion, figs. 1, 2, 4, magnetic tape, 0028), said print medium configured to receive and store printing information comprising data related to properties of the print medium (0020, 0021, the data storage device stores information to verify the authenticity of the print medium, which is equivalent to a property of the print medium);

wherein the printed image has been applied to the print medium (0022) and the data storage device comprises a rewritable magnetic strip (8) and the printing information comprises data related to the printed image (0021, 0022, the storage device may also store a duplicate of the printed image).

With regards to claims 8 and 16, an ink jet printing system (0011, 0017) comprising:

a print medium configured to receive a printed image (fig. 2, layer 10 receives printed image 14);

a rewritable data storage device (8) attached to the print medium (0019), said data storage device being positioned in or on only a portion of the print medium (central portion, figs. 1, 2, 4, magnetic tape, 0028), said print medium being configured to receive and store printing information (0020, 0021);

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a printer configured to print the image on the print medium (0011, 0017)  
and

a printing information processor associated with the printer, said printing information processor comprising a data read processor capable of writing data to the storage device (0020) and reading data from the data storage device (since the processor is capable of processing the data while writing the data, it is also capable of reading data from the data storage device in cooperation with a specific magnetic data reader).

With regards to claims 12, the data storage device comprises a rewritable magnetic strip (8).

With regards to claim 14, the printing information comprises information relating to properties of the print medium (the authenticity of the document).

With regards to claim 15, the printed image has been applied to the print medium and the printing information comprises data related to the printed image (0020, 0021, a duplicate of the printed image).

With regards to claim 18, the printer and the printing information processor are integrated (0020, the data is stored while the image is printed).

With regards to claims 20, 23 and 26, a method for associating printing information with a print medium, comprising the steps of:

attaching a rewritable data storage device comprising a rewritable magnetic strip (8) to a print medium (0019) said rewritable data storage device being positioned in or on only a portion of the print medium (central portion, figs. 1, 2, 4, magnetic tape, 0028); and

storing printing information on the data storage device, said printing information comprising data relating to properties of the print medium

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(authenticity) and including information relating to printed material applied to the print medium, on the data storage device (0020, 0021, duplicate of image data).

With regards to claims 27 and 28, a print medium (fig. 2) having a magnetic strip (8) as a data storage device attached thereto, said print medium being configured to receive a printed image (print medium has an ink receptive layer 10 to receive a printed image), and said data storage device being positioned in or on only a portion of the print medium (central portion, figs. 1, 2, 4, magnetic tape, 0028), said print medium being configured to receive and store printing information comprising data related to, but not entirely duplicative of, content of the printed image (0020, 0021, authenticity of the document).

With regards to claim 29, the printed image has been applied to the print medium, and the printing information further comprises data related to properties of the print medium (authenticity).

With regards to claims 30 and 31, a method for associating printing information with a print medium, comprising the steps of:

attaching a magnetic strip (8) as a data storage device to a print medium, said data storage device being positioned with respect to only a portion of the print medium (central portion, figs. 1, 2, 4, magnetic tape, 0028); and

storing printing information on the data storage device, said printing information comprising data related to, but not entirely duplicative of, content of a printed image applied to the print medium (0020, 0021, authenticity).

With regards to claim 32, the step of storing printing information on the data storage device includes the step of storing information relating to properties of the print medium (authenticity).

***Response to Arguments***

5. Applicant's arguments filed 26 April 2007 have been fully considered but they are not persuasive.

Applicant states that "the data storage device is in or on only a portion of the print medium. In other words, the storage device must be smaller than the print medium." In *Lee* the print medium contains multiple layers of distinct material, including ink receptive layer 10, magnetic layer 8 and a base layer 6. The magnetic layer 6 is not on the ink receptive layer, thus it is in or on only a portion of the print medium because it does not exist throughout the entire structure of the print medium (only a single layer) and it does not lay on top of all of the layers of the print medium (being on only a portion of the print medium, such as the base layer 6). The language "the data storage device is in or on only a portion of the print medium" is distinct from the language "the storage device must be smaller than the print medium". Furthermore, assuming *arguendo* that the noted language is synonymous with the language "the storage device must be smaller than the print medium", the dimensions of the storage layer 8, which include its length, width, and height, are smaller than the dimensions of the entire print medium.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

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Accordingly, from the above discussion, applicant's arguments concerning the teachings of Lee at paragraph 0028 are irrelevant because, absent this teaching, Lee discloses the claimed invention.

Nevertheless, these arguments have also been considered.

Applicant argues that "Lee never discloses the identical invention since Lee only discloses a print medium having a storage device of the same size". This is not true. Lee specifically mentions narrow magnetic tape and thus discloses such.

Applicant cites case law that states the basic premise of 35 U.S.C. 102, that a single reference must disclose each and every element of the claim. The important matter that applicant respectfully disregards is that Lee does in fact disclose the smaller magnetic recording layer, as evidenced by *Celeritas Technologies Ltd. v. Rockwell International Corp.*, 150 F.3d 1354, 1361, 47 USPQ2d 1516, 1522-23 (Fed. Cir. 1998), wherein the prior art mentioned that a modem with a single carrier data signal was less than optimal, and the court determined that this did not vitiate the fact that it is disclosed.

Applicant states that "the examiner is fully aware that the present reference is unavailable for a 103 rejection and therefore is attempting to disguise a 103 rejection as a 102 rejection".

This statement is respectfully unsubstantiated and inappropriate.



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**Conclusion**

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julian D. Huffman whose telephone number is (571) 272-2147. The examiner can normally be reached on 10:00a.m.-6:30p.m. Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Meier can be reached on (571) 272-2149. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



Julian D. Huffman  
Primary Examiner  
Art Unit 2853  
28 June 2007